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Appln. No. 10/609,431
Amendment dated August 5, 2004
Reply to Office Action mailed May 11, 2004

REMARKS

Reconsideration is respectfully requested.

Claims 1 and 3-7 remain in this application. Claim 2 has been cancelled.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraphs 1 and 2 of the Office Action

Claim 1 has been rejected under 35 U.S.C. §102(b) as being anticipated by Cartelli U.S. Patent No. 6,381,752; see figures 6, 7; and claim 1.

Claim 1, particularly as amended, requires that the retaining member engage the straps without requiring the strap to have "engagement elements" specifically holes, eyelets, or loops. This structure is shown in figure 2 as originally filed.

The Cartelli reference teaches a bra with selectively configurable straps using a stiffening element. Put differently the structure taught by Cartelli only works with bras having a series of engagement elements dispersed along a length of the straps, while the present invention has a structure which does not require the use of such elements.

Withdrawal of the §102(b) rejection of claim 1 is therefore respectfully requested.

Paragraphs 3-5 of the Office Action

Claims 1-3 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Norris U.S. Patent No. 5,590,545 in view of Cartelli U.S. Patent No. 6,381,752.

Claim 1, particularly as amended, incorporates the as-filed limitations of claim 2, specifically the prongs being essentially disposed in a plane with the elongate main portion.

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The Norris reference teaches a garment strap retainer with grip means (27) that are elevated above the plane of the body (17), and which work with the body to form a cavity (31) for receiving the strap of the garment. This increase thickness makes the garment strap retainer of Norris more visible under the garment being worn.

Similarly, the Cartelli reference teaches a device having a clasp 40 comprising a first portion 42 providing a pair of spaced apart first fastening means 44, and a second portion 46 providing a pair of spaced apart second fastening means 48. See figures 1 and 2 of Cartelli. This clasp structure similarly discloses a non-planar device, which like Norris is more susceptible to being visible underneath the garment being worn because of the added thickness.

It is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is submitted that the combination of Norris with Cartelli is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest a

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retainer having prongs being essentially disposed in a plane with the elongate main portion

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980)
(emphasis in original).

Withdrawal of the §103(a) rejection of claims 1-3 is therefore respectfully requested.

Paragraph 6 of the Office Action

Claims 4-7 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over the same references as applied to claims 1-3 above, and further in view of Wyeth U.S. Patent No. 1,401,227.

The office action states in part that Wyeth "...teaches the use of strap retainer (3) having an elongated main portion (4) and opposite end portions (5), wherein each of said end portions includes C-shaped prongs (7), wherein said prongs of one end portion facing the other prongs of the other end portion; see Figures 1-3; page 1, lines 30-53, and to further modify the

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shape of the prongs in Norris in the Manner taught, disclosed, and suggested by Wyeth, it would have been obvious to one skilled in the art at the time the invention was made."

However, Wyeth does not teach the use of the C-shaped prongs to engage the straps of the garment as suggested by the office action. Rather Wyeth teaches the use of a rubber band to engage the straps of the garment. Wyeth reads in part:

"Referring to the drawings, 1 is an undergarment having straps 2, which extend over the shoulder of the wearer. These straps often fall off of the shoulders of the wearer, causing much annoyance. In order to retain the shoulder straps in proper position, I provide a retainer 3, having a portion 4, preferably of elastic material, and having a celluloid, or other non-metallic fastener 5 at each end. These fasteners, as shown in figs. 2 and 3, have an elongated eye 6 through which the fabric 4 of the retainer is passed and secured by a row of stitches. At the end of the fastener 5 are hooks 7. The fastener is slotted at 8. *A rubber band 9 is passed through this slot 8 and one end of the rubber band is passed through the other end, as shown in Fig. 3, so as to attach the rubber band firmly to the material.*

Then the retainer is applied to the garment, the rubber band 9 is passed around the shoulder strap 2, and around hooks 7, as shown in Fig. 2, holding the retainer firmly to the strap." Column 1 lines 30-53. Emphasis Added.

It is respectfully submitted that the plain text of Wyeth teaches away from the combination put forth in the office action, and therefore the references do not provide the necessary motivation required to establish obviousness under 35 USC 103(a).

Withdrawal of the §103(a) rejection of claims 4-7 is therefore respectfully requested.

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CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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